

Docket number: 200311470-1

REMARKS

This Reply is in response to the Office Action mailed on 1/17/2007. Reconsideration and allowance of the application in view of the following is requested.

I. Title

The Office Action asserts that the "title of the invention" is not descriptive and requires a new title. Applicant traverses this requirement and requests withdrawal of the requirement for a new title.

In particular, the Office action asserts that the title is not descriptive. Applicant submits that the governing standards do not require the title to be "descriptive." Consequently, Applicant submits that the Office Action misstates the requirements of the title and, therefore, improperly requires a new title.

37 CFR 1.72(a) sets forth the requirements of the title as follows: "The title of the invention may not exceed 500 characters in length and ***must be as short and specific as possible***. (Emphasis added.)" Here, the current title of "media handling" is quite short at only two words. Further, the current title is specific in that it specifies the category (media handling) to which this subject matter pertains. Hence, Applicant submits that the current title complies with the requirements of 37 CFR 1.72(a). Because the current title complies with these requirements, Applicants request withdrawal of the requirement for a new title.

Moreover, Applicants submit that the title suggested in the Office Action is inappropriate for the present matter. Specifically, the title suggested is not "as short and specific as possible" since it includes nine words and is much longer than the present title. Further, the suggested title recites features not in all of the claims and, as such, is not specific to the subject matter recited in the claims. For example, claim 19 does not recite "a device" and other claims do not recite "cups". Accordingly, the suggested title is longer than possible and is not specific to claimed subject matter. Thus, Applicants submit that the current title complies with the title requirements and that the requirement for a new title be withdrawn.

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II. Claim Rejections § 102

A. Krueger

Claims 7-9 were rejected as anticipated by U.S. Patent No. 2, 231,339 to Krueger. These claims are cancelled, thus rendering moot the rejections thereof.

B. Wirz

Claim 19 is rejected as anticipated by U.S. Patent No. 4,378,734 ("Wirz"). In particular, the Office Action relies on lines 35-41 of column 1 of Wirz. Applicants submit that claim 19 is not anticipated by lines 35-41 of column 1 of Wirz on the basis that this text does not teach at least "the different locations being disposed along a line orthogonal to a direction of movement." Applicants note also that this section of Wirz appears to describe teachings of a different document, namely German Pat. No. 24 52 096.

Further, Wirz fails to disclose "the sheet of print media has a corrugated cross-section along the line orthogonal to a direction of movement;." Indeed, Wirz is silent regarding the cross-sectional shape of the print media. Wirz is also silent regarding the "a direction of movement of the print media". Rather, Wirz describes the "direction of motion of the rotary sucker" relative to "the sheet transfer cylinder" without reference to a direction of movement. Hence, the disclosure of Wirz is inapposite to the subject matter of claim 19.

Claim 20 is allowable for similar reasons as those set forth above with respect to claim 19 and further for the reasons set forth below.

Claims 20 and 21 recite means-plus-function elements. Accordingly, Applicant requests that the examiner apply the standards set forth in MPEP 2181 and examine any elements that are presumed to invoke 35 U.S.C. §112 6th paragraph in accordance with MPEP 2181-2183.

Further, MPEP 2183 sets forth the requirements for a prima facie case of equivalence of a means-plus-function claim element. In particular, this MPEP section specifies that Examiner provide "rationale in the Office action as to why the prior art

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element is an equivalent." The Office Action is silent in this respect and as such, does not establish prima facie equivalence of any elements recited in claims 20, 21 that are subject to a 35 U.S.C. §112 6th paragraph construction. Consequently, the Office Action also fails to allege equivalence of such elements. As such, Applicants cannot fully evaluate this basis of rejection of claims 20, 21 since it is not set forth as the MPEP requires. Applicant requests withdrawal of the rejection of claims 20,21.

III. Claim Rejections § 103

Claims 1, 2, 4, 5, 13, 14, 16, and 17 stand rejected as unpatentable over Krueger in view of Hudson (U.S. 2004/0113349). Applicants traverse these rejections on the basis that the Office Action does not establish prima facie obviousness of these claims.

The Office Action fails to establish prima facie obviousness of claim 1 because Krueger in view of Hudson fail to disclose all claim limitations of claim 1. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03. Here, Krueger in view of Hudson fail to disclose "a conveyor adjacent to the cups for transferring the print media from the cups to a print engine" as recited in claim 1. In particular, Krueger does not disclose a print engine whatsoever since Krueger relates to a "mechanism for feeding metal sheets".

Hudson also fails to disclose "a conveyor adjacent to the cups for transferring the print media from the cups to a print engine." Specifically, Hudson does not disclose structure for transferring media *to a print engine* but rather relates to a finisher that transfers printed media to an output tray for stacking after the media has been printed upon. Hence, Hudson is silent regarding a conveyor for transferring media *to a print engine*.

Consequently, because neither Krueger nor Hudson disclose "a conveyor adjacent to the cups for transferring the print media from the cups to a print engine" as recited in claim 1 the Office Action fails to establish prima facie obviousness of claim 1. Withdrawal of this rejection is therefore requested.

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Claims 2, 4, and 5 depend upon claim 1 and are allowable for at least the same reasons as claim 1 is allowable. Withdrawal of these rejections is requested.

With respect to claim 13, Applicant submits that there is no motivation to modify the Krueger sheet feeding mechanism with a print engine for forming an image on the medium. Indeed, Krueger is "concerned with mechanism for feeding metal sheets from which tin cans and the like are formed." (Col. 1, lines 6-8). As such, Krueger is not directed to printing or to having print media. Indeed, there is no teaching in either Krueger nor Hudson relating to the desirability of printing on metal sheets handled by the Krueger mechanism. Moreover, there is no teaching that liquid electrophotography techniques would be effective in printing on the Krueger metal sheets. Consequently, because neither Krueger nor Hudson disclose the desirability or feasibility of printing on the Krueger metal sheets, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 13 due to a lack of motivation to modify Krueger with the teachings of Hudson. (See 2143.01 "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION"). Withdrawal of this rejection is requested.

Further, the Office Action fails to establish *prima facie* obviousness of claim 13 because of a lack of reasonable expectation of success in modifying Krueger with a print engine to print on the Krueger metal sheets. "The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success." MPEP 2143.02. Here, the Office Action does not establish a reasonable expectation of successfully modifying Krueger to print on metal sheets since neither Krueger nor Hudson disclose the desirability or feasibility of printing on the Krueger metal sheets. Withdrawal of this basis of rejection is requested for this additional reason.

Claims 14 and 16 depend upon claim 13 and are allowable for at least the same reasons claim 13 is allowable.

Applicants submit that the Office Action also fails to establish *prima facie* obviousness of claim 17 for reasons similar to those set forth above with respect to claim 13. Withdrawal of this rejection is requested.

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Claim 15 depends upon claim 13 and is allowable for at least the same reasons as claim 13.

IV. Allowable Subject Matter

Claims 10 and 18 are allowed.

In this regard, Applicant agrees with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate, or render obvious the invention as claimed, independent of how the invention is paraphrased.

V. Conclusion.

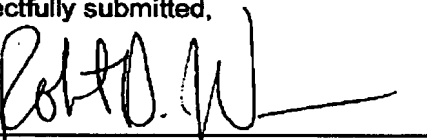
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Date

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO at (571) 273-8300 on Apr 12, 2006.


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